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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,327	01/08/2001	Kevin M. Johnson	DESCON 00.01/02	6727

7590 03/17/2005

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EXAMINER

LAMBRECHT, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,327

Applicant(s)

JOHNSON, KEVIN M.

Examiner

Chris Lambrecht

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 12-45 and 50-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 46-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/11/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. claims 1-11 and 47-49, directed towards a system and method for capturing Internet access information in a video system;
- II. claims 23-37 and 53-59, directed towards a system and method for capturing Internet access information related to a physical item;
- III. claims 12-22, 38-41, 50-52, and 60, directed towards a system and method for capturing Internet access information in an audio system;
- IV. claims 42-45 and 61-66, directed towards a system and method for capturing Internet access information based on geographical position.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 46 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Steven Grossman on 23 February 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11 and 47-49, 46 generic. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-45 and 50-66 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

-or-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 46 and 47** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,637,028 to Voyticky et al. (hereinafter "Voyticky").

Regarding **claims 1, 46 and 47**, Voyticky discloses a system (fig. 1) and corresponding method for capturing Internet access information related to a selected television broadcast based

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upon the variables of time and channel (where the content appearing on a particular channel comprises a visual aspect) associated with said broadcast, comprising:

- (a) a capture unit (remote control **105**, fig. 1) comprising:
 - (i) a database (table, col. 7, ll. **53-57**) for receiving and storing the time and channel of said selected television broadcast (col. 5, ll. **62-66**);
 - (ii) a selector (event button, col. 5, ll. **62-66**) which upon activation thereof stores said time and channel of said selected television broadcast;
- (b) an interface (computer **106**, fig. 1) for coupling said capture unit (**105**) to said Internet (via IR, RF, etc., col. 6, ll. **1-15 & 50-53**) to access Internet information wherein said interface extracts links from an Internet web site which supplies said information related to said time and channel stored in said capture unit database (col. 17, ll. **22-25, 49-51, 57-61**, and col. 18, ll. **24-29**).

As for **claim 2**, Voyticky discloses the system of claim 1, wherein said capture unit (**105**, fig. 1) contains a clock (col. 10, ll. **18-23**) and said clock identifies a time (time stamp) associated with said channel stored in said capture unit database (col. 10, ll. **33-40**).

5. **Claims 4-6, 8-10, 48 and 49** are rejected under 35 U.S.C. 102(b) as being anticipated by International Publication No. WO 98/17064 of Macrae et al. (hereinafter "Macrae").

Regarding **claims 4 and 48**, Macrae discloses a system (fig. 7) and correspond method for capturing Internet access information related to a selected television or video broadcast based upon a signal separate from the video or audio signal (i.e., the data inserted within the blanking interval of the video signal constitutes a signal separate from the video or audio signal) for said television or video broadcast signal (p. 9, ll. **17-20**) comprising:

- (a) a capture unit (TV **70**, fig. 7) comprising:

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- (i) a database (directory) for receiving and storing said separate signal of said selected television or video broadcast (p. 10, ll. 13-14);
- (ii) a selector (store button 55, fig. 7) which upon activation thereof stores said separate signal of said selected television or video broadcast (p. 10, ll. 7-14);
- (b) an interface (Internet access terminal 74, fig. 7) for coupling said capture unit to said internet to access internet information wherein said interface extracts links from an internet web site which supplies said information related to said separate signal stored in said capture unit database (p. 10, ll. 30-36).

As for **claim 5**, Macrae discloses the system of claim 4 wherein said video broadcast comprises video produced from a device that plays prerecorded video (playback device associated with videotape provided to broadcaster, p. 9, ll. 11-16).

As for **claim 6**, Macrae discloses the system of claim 4 wherein said capture unit contains a clock and said clock identifies a time associated with said selected separate signal (where said unit maintains an awareness of the "least-recently accessed" website address stored therein, p. 10, ll. 21-29, it inherently contains a clock that identifies a time associated with said selected separate signal).

Regarding **claims 8 and 49**, Macrae discloses a system (fig. 7) and corresponding method for capturing Internet access information related to a selected television or video broadcast based upon a selected signal within the video or audio signal (i.e., the vertical blanking interval in which the data is inserted is within video signal) for said television or video broadcast signal (p. 9, ll. 17-20) comprising:

- (a) a capture unit (RAM 90, fig. 7) comprising:

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- (i) a database (directory) for receiving and storing said selected signal within said selected television or video broadcast (p. 10, ll. 13-14);
- (ii) a selector (store button 55, fig. 7) which upon activation thereof stores said selected signal within said selected television or video broadcast (p. 10, ll. 7-14);
- (b) an interface (Internet access terminal 74, fig. 7) for coupling said capture unit to said internet to access internet information wherein said interface extracts links from an internet web site which supplies said information related to said selected signal stored in said capture unit database (p. 10, ll. 30-36).

As for **claim 9**, Macrae discloses the system of claim 8 wherein said video broadcast comprises video produced from a device that plays prerecorded video (playback device associated with videotape provided to broadcaster, p. 9, ll. 11-16).

As for **claim 10**, Macrae discloses the system of claim 8 wherein said capture unit contains a clock and said clock identifies a time associated with said selected separate signal (where said unit maintains an awareness of the "least-recently accessed" website address stored therein, p. 10, ll. 21-29, it inherently contains a clock that identifies a time associated with said selected separate signal).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Voyticky in view of U.S. Patent No. 6,446,261 to Rosser (hereinafter "Rosser").

Regarding **claim 3**, Voyticky discloses the system of claim 1 wherein said interface extracts links from an internet web site which supplies said internet access information related to said selected and/or separate signal (see above). However, Voyticky fails to disclose a global positioning system which identifies and stores GPS coordinates and said information is related to said GPS coordinates.

In an analogous art, Rosser discloses a global positioning system which identifies and stores GPS coordinates (col. 3, ll. 33-37 and col. 11, ll. 21-26) and said information is related to said GPS coordinates (col. 12, l. 55 – col. 13, l. 4), for the purpose of enabling broadcasters to provide geographically targeted advertising (col. 13, ll. 4-12).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Voyticky to include a global positioning system which identifies and stores GPS coordinates and said information is related to said GPS coordinates, as taught by Rosser, for the purpose of enabling broadcasters to provide geographically targeted advertising in a television broadcasting system.

8. **Claims 7 and 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Macrae in view of Rosser.

Regarding **claims 7 and 11**, Macrae discloses the systems of claims 4 and 8 wherein said interface extracts links from an internet web site which supplies said internet access information related to said selected and/or separate signal (see above). However, Macrae fails to disclose a global positioning system which identifies and stores GPS coordinates and said information is related to said GPS coordinates.

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In an analogous art, Rosser discloses a global positioning system which identifies and stores GPS coordinates (col. 3, ll. 33-37 and col. 11, ll. 21-26) and said information is related to said GPS coordinates (col. 12, l. 55 – col. 13, l. 4), for the purpose of enabling broadcasters to provide geographically targeted advertising (col. 13, ll. 4-12).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Macrae to include a global positioning system which identifies and stores GPS coordinates and said information is related to said GPS coordinates, as taught by Rosser, for the purpose of enabling broadcasters to provide geographically targeted advertising in a television broadcasting system.

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Conclusion

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M Lambrecht whose telephone number is (571) 272-7297. The examiner can normally be reached on 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher M Lambrecht
Examiner
Art Unit 2611

CML


HAITRAN
PRIMARY EXAMINER